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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,193	03/25/2002	Jean-Pierre Molitor	H 4157 PCT/US	1128

23657 7590 07/12/2006

COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

MARX, IRENE

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/980,193	Applicant(s) MOLITOR ET AL.	
	Examiner Irene Marx	Art Unit 1651	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Irene Marx
Primary Examiner
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Response to Arguments

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant argues that the use of a microemulsion as a carbon source or a substrate provides many advantages to the fermentation medium for the fermentation process. That may be so. However, the invention as claimed does not set forth that a carbon source or a substrate are specifically adapted for a particular microorganism. It is noted that the microorganism is undefined and the amount comprised by the emulsion is not particularly defined either. Applicant argues that the microemulsion of a fatty acid alkyl ester or a vegetable triglyceride act as a carbon source or a substrate in a fermentation process. However, this is incorrect. The claim as written is directed to a medium comprising a microorganism and fatty acid alkyl esters, vegetable triglycerides or mixtures thereof **comprising** at least one of a carbon source or a substrate. The microemulsion contains a carbon source or substrate in a fermentation process in an undetermined amount, including traces of any carbon source or any "substrate". The arguments directed to "substantial" amounts are unwarranted in the context of the instantly claimed invention. Specific amounts are not claimed.

Applicant's arguments are inconsistent. On the one hand, applicant argues that the amount of fatty acid or triglyceride in Inlow does not decrease. On the other hand applicant argues that the yeast of Kopp Holwiesche uses the methyl laurate as a carbon source, even though it is not in a microemulsion.

Applicant is reminded that the claims are not directed to a process of digesting fatty acid alkyl esters or vegetable triglycerides. The intended use of a composition does not *per se* render the composition patentable, as appears to be contended by applicant with respect to Inlow *et al.* (Response, page 6) and the secondary references. Similarly, applicant argues that the lipids of the present invention are present in a range from 20-60 g/l. If this amount is important to the inventive concept, it should be claimed appropriately.

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With respect to applicant's arguments that the Examiner is stretching the concept of a fermentation medium, it is noted that the PTO must give claim words their broadest reasonable meaning in their ordinary usage, as understood by one of ordinary skill in the art taking into account whatever enlightenment by way of definitions or otherwise that may be afforded written description contained in the applicant's specification. In *re Morris*, 127 F.3d 1048, 44 U.S.P.Q.2d (Fed. Cir. 1997). No particular definitions are found in the as filed specification. Applicant argues that the ingredients in Forster *et al.* such as perfumes, deodorizing agents and light-protective factors in the emulsion "would not be suitable as a fermentation medium useful in the practice of the present invention." The "present invention" is directed to "a reaction medium comprising a microorganism and fatty acid alkyl esters, vegetable triglycerides or mixtures thereof comprising at least one of a carbon source or a substrate." It is noted that Forster *et al.* does not teach that the composition can be used for fermentation, however, the intended use of the composition does not distinguish the composition since such undisclosed use flows from Forster *et al.* composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus, the intended use is not limiting.

That a fermentation process may be unintended, unwanted or deleterious does not detract from the fact that a composition constitutes a proper "fermentation medium" if it is capable of supporting microbial growth.

The extensive arguments by counsel directed to the benefits of the invention disclosed in the specification and well as the amounts used to prepare a touted fermentation medium are not clearly relevant to the invention as claimed. In addition, no evidence is of record to demonstrate unexpected results for the invention **as claimed**.

The scope of the showing must be commensurate with the scope of claims to consider evidence probative of unexpected results, for example. In *re Dill*, 202 USPQ 805 (CCPA, 1979), In *re Lindner* 173 USPQ 356 (CCPA 1972), In *re Hyson*, 172 USPQ 399 (CCPA 1972), In *re Boesch*, 205 USPQ 215, (CCPA 1980), In *re Grasselli*, 218 USPQ 769 (Fed. Cir. 1983), In *re Clemens*, 206 USPQ 289 (CCPA 1980). It should be clear that the probative value of the data is not commensurate in scope with the degree of protection sought by the claim.

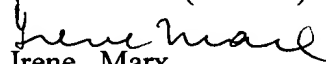
Therefore the rejection is deemed proper and it is adhered to.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Irene Marx
Primary Examiner
Art Unit 1651